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PATENT

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Tsuyoshi MORIYAMA, et al.

Serial No.: 09/737,280

Filed: 15 December 2000

Title: SHEET HANDLING APPARATUS WHICH  
INSERTS SHEETS BETWEEN ...

Group Art Unit: 3653

Examiner: J. Shapiro

Attorney Docket No.: CANO:016

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COVER SHEET 1

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LYLE KIMMS

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REQUEST FOR PRE-APPEAL BRIEF REVIEW

Sir:

Applicants request review of the Final rejection. No amendment is filed with this request.  
A Notice of Appeal is concurrently filed with this request.

SN. 09/737,280

ATTORNEY DOCKET NO. CANO:016

REMARKS

Claims 1-23, 47-65, 75, 76, and 78 remain pending in this application. The examiner rejected these claims under 35 U.S.C. § 103(a) as unpatentable over Nyffeneger (USP 5,826,869) alone or in view of Inoue (USP 5,159,546).

Independent claims 1, 47, 76, and 78 call for a plurality of insert sheet feeding modes, which correspond, for example, to S-stacking mode appearing in Fig. 7A and F-stacking mode appearing in Fig. 7B, respectively. In one sheet feeding mode, such as the S-stacking mode, insert sheets can be fed from a plurality of inserter feed trays. That is, the insert sheets of the same page can be stacked on one of the inserter trays so that the insert sheets of the same page can be fed from the one inserter tray and insert sheets of different pages can be fed from different inserter trays. In another sheet feeding mode, one inserter tray can feed the insert sheets. That is, insert sheets of different pages can be stacked on the one inserter tray so that insert sheets of different pages can be fed from the one inserter tray unless the one inserter tray is empty.

Independent claims 48, 57, and 75 call for at least two kinds of stacking manners, such as the S-stacking mode and the F-stacking mode mentioned above. When one of the sheet feeding manner is selected, e.g., F-stacking mode, the insert sheet feeding is controlled to feed insert sheets from the one inserter tray without interrupting a job being executed when the insert sheets are re-stacked on the one inserter tray after exhausting all the insert sheets stacked on the one inserter tray.

The examiner contends that it would have been obvious for Nyffeneger to control the feeding of insert sheets in any manner as desired by the user because it is computer controlled. In other words, according to the examiner, if an apparatus is computer controlled, it can be programmed to do as desired by the programmer, including the sheet feeding control as claimed. Applicants submit that the examiner's rationale for rejecting a claim is facially improper because the examiner does not provide any motivation for doing what the claims call for. Specifically, as set forth in the seminal Supreme Court case, *Graham v. John Deere*, to establish a prima facie case of obviousness, the examiner must identify a teaching or suggestion of the desirability of doing what the inventors here have done. That is, to establish that the claimed invention is directed to an obvious subject matter, either the applied reference(s) must expressly or implicitly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why an ordinary artisan would have found the claimed invention to have been obvious in light of the teaching(s) of the applied reference(s).

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See MPEP §§ 2142, 2143. The suggestion or the examiner's reasoning, however, must be objective and supported by evidence.

The fact that a controller can be programmed to do control the sheet feeding as set forth in the claims is not germane to the issue of patentability under § 103. That is akin to relying on an obvious-to-try rationale rather than basing on what the applied references teach. What is germane is whether the applied references would have provided support or motivation for doing what the claims call for. The examiner simply fails to provide any support or motivation as to why one of ordinary skill in the art would control the feeding of insert sheets as set forth in the claims.

Nyffeneger discloses a plurality of insert hoppers "a" through "n" that is computer controlled. Although Nyffeneger discloses a controller for feeding insert sheets from the insert hoppers, it is silent regarding how the insert sheets are fed. That is, Nyffeneger fails to disclose that it provides different feeding modes, let alone providing any specifics of any feeding mode. Therefore, Nyffeneger would not have provided a prima facie case of obviousness for controlling the feeding of the insert sheets as set forth in the independent claims.

Inoue would not have alleviated the shortcomings of Nyffeneger (or vice-versa) because Inoue also would not have taught providing different insert sheet feeding modes other than manual and automatic. As explained in the prior reply, element 2006 in Fig. 30 refers to different copying modes, not insert sheet feeding modes. Although element 2002 in Fig. 30 refers to paper trays for feeding insert sheets, Inoue, like Nyffeneger, does not disclose how insert sheets are fed. Rather, Inoue merely illustrates in Fig. 30 that it has manual and automatic modes without any elaboration. Applicants submit that neither Nyffeneger nor Inoue discloses or teaches providing insert feeding modes as set forth in the claims.

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Conclusion

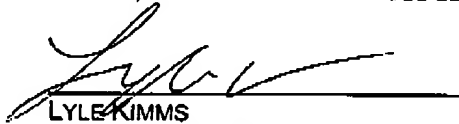
Applicants submit that the applied references teach nothing resembling what the claims call for, and they simply would not support a prima facie case of obviousness. Applicants look forward to receiving the review panel's decision on the propriety of the art rejections.

Respectfully submitted,

ROSSI, KIMMS &amp; McDOWELL LLP

07 NOVEMBER 2005

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LYLE KIMMS

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